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OFFICE OF PETITIONS

In re Patent No. 7,543,024	:	DECISION
Mary A. Holstege	:	DISMISSING REQUEST FOR
Issue Date: June 2, 2009	:	RECONSIDERATION OF PATENT
Application No. 09/848,987	:	TERM ADJUSTMENT
Filed: May 3, 2001	:	UNDER 37 CFR 1.705
Attorney Docket No.	:	
021756-016000US	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION," filed on June 4, 2009. Patentees request that the Patent Term Adjustment for the above-identified patent be increased by 306 days from 688 days to 994 days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of 688 days.

BACKGROUND

On June 2, 2009, the above-identified application matured into U.S. Patent No. 7,543,024, with a revised Patent Term Adjustment of 688 days. On June 4, 2009, the subject request for reconsideration was timely filed within two months of the patent issue date.

The Office determined that the 473 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) overlaps with the 841 (806 + 35) days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1) and (a)(2) accorded prior to the filing of the request for continued examination. As such, no additional days of patent term adjustment were entered at issuance under the three-year pendency provision. Given the additional Office delay under 37 CFR 1.702(a)(2) and (a)(4) of 42 (11 + 31) days and the applicant delay of 195 days, the patent issued with a revised patent term adjustment of 688 (883 (841 + 42) - 195) days.

On June 4, 2009, patentee timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 994 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts that pursuant to Wyeth, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same calendar day or days." Patentee maintains that the total non-overlapping PTO delay under §154(b)(1)(A) & (B) is 1189 (852 + 473 - 136 overlap) days as these periods do not occur on the same day. Further, given the applicant delay of 195 days, patentee asserts entitlement to 994 (1189 - 195) days of patent term adjustment.

OPINION

Preliminarily, it is noted that patentee has omitted the period of 31 days of Office delay pursuant to 37 CFR 1.704(a)(4) accorded for issuance of the patent on June 2, 2009, four months and 31 days after payment of the issue fee on January 2, 2009. Patentee's argument will be articulated to include this 31 day period of Office delay.

Patentee's interpretation of the period of overlap has been considered, but found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment

under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application (or, in an international application, the date that the national stage commenced under 35 U.S.C. 371(b) or (f)), is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the application filing date, May 3, 2001, and ending on the date of filing of a request for continued examination (RCE), August 19, 2005 (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)). The relevant period ends with the filing of the RCE as the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) does not include the period subsequent to the filing of the RCE. 35 U.S.C. 154(b)(1)(B)(i).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1) and (a)(2), 841 days of patent term adjustment were accorded during the pendency of the application for Office delay prior to the filing of the request for continued examination. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 472 days of patent term adjustment accrued for Office issuance of the patent more than 3 years after the filing date of the application for the period beginning on May 4, 2004, and ending on August 18, 2005.

The 472 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 841 days of patent term adjustment under 37 CFR 1.702(a)(1) and (a)(2). Entry of both the 841 days and the 472 days is neither permitted nor warranted. Considering the Office delay of 42 days under 37 CFR 1.702(a)(2) and (a)(4) which

occurred subsequent to the filing of the RCE, and the applicant delay of 195 days, the patent term adjustment is 688 days.

CONCLUSION

In view thereof, no change will be made in the revised determination of patent term adjustment at the time of the issuance of the patent.

As the request of January 2, 2009, was held in abeyance by the decision of April 22, 2009, no additional fee is required.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood, at (571) 272-3231.



Anthony Knight
Supervisor
Office of Petitions